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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,148	02/15/2002	Michael J. Sullivan	P-5474-D1-C1-C1	5579

24492 7590 12/19/2002

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EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,148

Applicant(s)

SULLIVAN ET AL.

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-15-02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 66-85 have been renumbered to claims 38-57.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-42, 44, 45, 47, 48, and 51-56 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamagishi et al (5,779,563). Regarding claim 38, Yamagishi discloses a golf ball comprising a solid core, an inner cover layer and an outer cover layer (abstract). The inner cover layer is made from Himilan, a well-known trade name for ionomer resins (table 4, col 9). The outer cover layer is made from polyurethane and has a Shore D hardness from 40 to 68 (col 4, lines 5-16; table 2). Regarding claim 40, the ball has a diameter of 42.7 mm or 1.68 inches (table 4). Regarding claim 42, the outer cover layer has a Shore D

Art Unit: 3711

hardness from 40 to 68 (col 4, line 7). Regarding claims 44 and 45, the outer cover layer has a thickness from 0.3 to 2.5 mm or 0.01 to 0.098 inch (col 4, lines 35-37).

Regarding claim 47, the solid core is made from a polybutadiene (col 3, lines 2-7). The outer cover layer is made from polyurethane and has a Shore D hardness from 40 to 68 (col 4, lines 5-16). Regarding claims 51 and 52, the outer cover layer has a thickness from 0.3 to 2.5 mm or 0.01 to 0.098 inch (col 4, lines 35-37). Regarding claim 53, the solid core is made from a polybutadiene (col 3, lines 2-7). The inner cover layer is made from Himilan, a well-known trade name for ionomer resins (table 4, col 9). The outer cover layer is made from polyurethane and has a Shore D hardness from 40 to 68 (col 4, lines 5-16). Regarding claim 55, the ball has a diameter of 42.7 mm or 1.68 inches (table 4). Regarding claims 39, 41, 48, 54, and 56 applicant claims PGA compression and coefficient of restitution; the properties are obvious over Yamagishi. Yamagishi discloses a solid golf ball comprising a polybutadiene core, an ionomeric inner cover, and a polyurethane outer cover. Applicant claims the same materials disclosed by Yamagishi for each layer. Furthermore, although Yamagishi is silent to the properties one skilled in the golf ball art is aware that golf ball commonly have a PGA compression between 70 and 100. Golf balls outside this range are usually discarded. Golf balls with a very low PGA compression are too soft for use and golf ball with a very high PGA compression are too hard. The coefficient of restitution (COR) also has a common range in the golfing art between 0.7 and 0.8. Golf balls do not have low COR values because the collision between the ball and club would not be satisfactory and would not give the ball proper initial velocity. One of ordinary skill in the art would have

modified the values of the properties to obtain the desired flight characteristics of the golf ball.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 5,971,870 in view of Yamagishi et al (5,779,563). The present invention and the '870 patent claim a golf balls comprising a solid core and a cover layer, where each layer has identical properties. The present invention further claims a single and dual cover layer. The dual cover layer comprises an inner cover layer made from an ionomer and an outer cover layer made from polyurethane. The '870 patent claims an outer cover made from an ionomer and does not claim an inner cover layer. However, Yamagishi teaches a golf ball comprising a single or dual cover, where the inner cover is an ionomer resin (col 9, table 4; col 4, lines 38-41). Yamagishi also teaches an outer cover

Art Unit: 3711


made from ionomer resins or polyurethanes (col 4, line 16-17). One of ordinary skill in the art would have modified the '870 patent in view of Yamagishi by adding an additional cover layer and a polyurethane outer cover layer to obtain a more durable golf ball.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on 7:30 AM to 5:00 PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Raeann Gorden
Patent Examiner
AU 3711

Rg
December 14, 2002